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10/020,094	12/13/2001	Thomas E. Coverstone	8931.002.NPUS00	9964
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HOUSTON OFFICE OF NOVAK DRUCE AND QUIGG LLP 1000 LOUISIANA STREET FIFTY-THIRD FLOOR HOUSTON, TX 77002				
EXAMINER				
D AGOSTA, STEPHEN M				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/020,094

Applicant(s)

COVERSTONE, THOMAS E.

Examiner

Stephen M. D'Agosta

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 76-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 76-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments, see amendment filed 6-9-2009, with respect to the rejection(s) of the claim(s) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

1. New prior art (which pre-dates the applicant's affidavit) has been found/added.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 76 and 78 rejected under 35 U.S.C. 102(b) as being anticipated by Hidary.

As per **claim 76**, Hidary teaches a wireless communication system for use with a wireless communication device and a position location system providing position location data indicating positions of the wireless communication device as the wireless communication device moves (Abstract teaches a wireless network/user and determining location of the user C3, L4-17), said wireless communication system comprising:

a memory containing a database of user selections (figure 1 shows a MEMORY BANK #22 and another MEMORY BANK with User Profile which can contain user preferences/selections, see C3, L18-24) and ,

a processor for receiving the position location data from the position location system and for processing the position location data to determine when the position location data indicates that the wireless communication device becomes in proximity to a certain location and the database of user selections contains a selection of the user of the wireless communication device indicating that the user of the wireless communication device has an interest in receiving an advertisement when the wireless communication device becomes in proximity to the certain location (C3, L 4-29 teaches determining user location and then reading the user's preferences based on user-provided information and then sending selected advertisement), and

a transmitter for transmitting the advertisement of the business at the certain location to the wireless communication device in response to the processing of the position location data determining that the wireless communication device has become in proximity to the certain location and the database of user selections contains a selection of the user of the wireless communication device indicating that the user of the wireless communication device has an interest in receiving an advertisement when the wireless communication device becomes in proximity to the certain location (C3, L4-50 which teaches, for example, that the user has a 4 year old car and may want an advertisement from a local car dealer).

As per **claim 78**, Hidary teaches claim 76, wherein the wireless communication device is a cell phone (Hidary teaches a cellular network and cell phone users, see figure 1, #16a).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 77 rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary and further in view of Owensby.

As per **claim 77**, Hidary claim 76, **but is silent on** wherein the position location system is the Global Positioning Satellite (GPS) system.

Owensby teaches providing targeted messages to a mobile (eg. advertisements, etc) and location determination which can use triangulation, GPS, etc. (see Abstract, C15, L50-60 for advertisements and C12, L30-40 for GPS).

It would have been obvious to one skilled in the art at the time of the invention to modify Hidary, such that GPS is used, to provide a more accurate location determination technology which is better than using either CELL-ID or Triangulation to fully understand the exact location of a user for targeted marketing.

Claims 79-80 rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary/Owensby and further in view of Taylor.

As per **claim 79**, Hidary teaches claim 76, wherein the memory further contains a information (eg. data or database) of user purchases, and wherein the processor is coupled to the memory for accessing the database of user purchases to determine whether or not purchases made by the user of the wireless communication device indicates that transmission of the advertisement of the business at the certain location to the wireless communication device may be of interest to the user of the wireless communication device, and the processor is coupled to the transmitter for enabling the transmitter to transmit the advertisement at the certain location to the wireless communication device only when purchases made by the user of the wireless communication device indicates that transmission of the advertisement at the certain location to the wireless communication device may be of interest to the user of the wireless communication device (C3, L39-50: The messages stored in memory bank 26 and delivered to the subscriber may be any one of a plurality of messages dependent on the subscriber's profile and location of cell 11. For example, if the subscriber has indicated that he likes to go to the movies, the message delivered during step 114 from memory 60 may be a brief advertisement for a recently released movie and where that movie is playing in, or close to cell 11. If the subscriber indicates that he is an avid sports fan, the message from memory 64 may indicate when the subscriber's favorite team plays in his area. If his profile indicates that he has a four year old car, the message may be an advertisement from a local car dealer for a new car) but is silent on including a history of purchases made by the user of the wireless communication device.

Hidary's user profile can be viewed as storing answers about user purchases which would be broadly interpreted as "a history of purchases" (eg. the example

discloses asking the user how old their car is). The examiner notes that smaller-ticket purchases could be determined as well (eg. a question about how much or how often does a user shop for food, clothing, household items, etc) which would better parallel a "history" (instead of just a big-ticket purchase like a car).

At least **Owensby** teaches using "historical" data for targeting advertising data at/to a user (Abstract teaches storing/tracking historical answers or movements of a user, eg. where "answers" would be "how often do you shop for food?" and can infer a history, also see C1, L25-35: In another alternative embodiment, the commercial information or advertisements are further targeted to the subscriber on the basis of Historical Response Data relating to the responses made to the targeted messages previously provided to the subscriber, note that "targeted messages" can be question(s) relating to if the user just purchased a good/service).

Furthermore, **Taylor** teaches tracking/storing a user's purchase history: It would be very desirable to substitute a system that automatically kept track of purchases and awarded discounts or coupon equivalents automatically depending upon current purchases and/or history of purchases, broken down by brand and in other ways. (C2, L1-10)

It would have been obvious to one skilled in the art at the time of the invention to modify Hiday, such that a history of purchases is tracked/stored, to provide means for the advertisers to know what a user has purchased before in order to target their marketing material based on user purchases trend data.

As per **claim 80**, Hidary teaches claim 76, wherein the memory further contains a history of positions of the wireless communication device, and wherein the processor is coupled to the memory for accessing the location of the wireless communication device to determine whether or not the position of the wireless communication device indicates that transmission of the advertisement at the certain location to the wireless communication device may be of interest to the user of the wireless communication device, and the processor is coupled to the transmitter for enabling the transmitter to transmit the advertisement of the business at the certain location to the wireless communication device only when the position of the wireless communication device indicates that transmission of the advertisement the certain location to the wireless communication device may be of interest to the user of the wireless communication device (Hidary teaches determining a user's position for targeting advertisements, see above) **but is silent on** a history of positions.

Owensby clearly teaches that a user's location history can tracked/stored (In yet another alternative embodiment, the commercial information or advertisements are further targeted to the subscriber on the basis of Historical Response Data relating to the historical movement patterns of the subscriber, C1, L25-35)

Furthermore, **Taylor** teaches tracking/storing a user's purchase history: It would be very desirable to substitute a system that automatically kept track of purchases and awarded discounts or coupon equivalents automatically depending upon current purchases and/or history of purchases, broken down by brand and in other ways. (C2, L1-10)

It would have been obvious to one skilled in the art at the time of the invention to modify Hidary, such that a history of positions is tracked/stored, to provide means for the advertisers to know where a user has been before and where they are roaming to in order to target their marketing material.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on 571-272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen M. D'Agosta/
Primary Examiner, Art Unit 2617